



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/977,591	11/25/1997	JUNICHI NAKATA	450100-4193	3294
20999	7590	01/02/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			TRAN, HAI V	
			ART UNIT	PAPER NUMBER
			2611	
			DATE MAILED: 01/02/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/977,591

Applicant(s)

NAKATA ET AL.

Examiner

Hai Tran

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/27/03 have been fully considered but they are not persuasive.

The applicant argues page 11 of amendment "in amended claim 1, when switching from providing the information signal by the 1st device to providing information signal by the 2nd device, the recipient remains the same... This example appears to show communication within two unrelated pairs of devices. It does not appear that this example describes providing an information signal from a 1st device to a recipient then from the 1st device and a 2nd device to that same recipient, and then from the 2nd device to that same recipient, as called in amended claim1 when switching from the 1st device to the 2nd device..."

In response, the Examiner respectfully disagrees with Applicant because the Examiner could not determine that the 1st device and 2nd device claimed is one pair of related devices or two unrelated pairs of devices. However, the Examiner could further elaborate by another example as suggested by Applicant for one pair of related devices, i.e. the reproducing device DVD 106 playbacks the video signal an record the video signal on the DVCR1 108, the user drag/drop the DVD 106 to a 2nd DVCR2 112 connected to the network. By doing so, the lwamura's system determines that the 1st DVCR1 does not need to receive the video signal from DVD 106 but the 2nd DVCR2

now does and notify the DSS 100 to route/switch the video playback signal from DVD 106 to the 2nd DVCR2 and DVCR1 stops recording.

As to claim 12, Applicant argues, "...it does not appear that this example addresses a wireless transmission of a control signal including an identification code identifying a recipient..."

In response, Iwamura drags/drops from one device to another device (recipient), the remote control must transmits a remote control signal along with the device lds (recipient's id) so the system could identify the "recipient" device by comparing with the topology/connection map see Col. 8, lines 18-42;

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 9-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 recites the limitation "a recipient of the information signal" in line 4 and "the recipient" in lines 6, 7 and 8.

Claim 13 recites the limitation "a recipient of the information signal" in line 4 and "the recipient", lines 5, 7, 8 and 9

Claim 14 recites the limitation "a recipient of the information signal" in line 4 and "the recipient", lines 5, 7, 8 and 9.

Claim 15 recites the limitation "a recipient of the information signal" in line 5 and "the recipient", lines 6, 8, 9 and 10.

It is unclear how "a recipient of the information signal" and "the recipient" claimed are related to the 1st and 2nd device in claims 1, 13, 14 and 15 and how the recipient is defined according to the Applicant's specification? It appears that the recipient is defined as elements 9 and 18 in Fig. 1, 8.

2. Claim 18 further recites, "the recipient is a human user". It is unclear how "the recipient is a human user" is related to "a recipient of the information signal"; "the detected recipient" and "the recipient" claimed in claim 1.
3. Claims 1-7, 8-18 recites the limitation "the recipient" in claims 1, 3, 4, 7, 12, 13, 14, 15, 16, 17 and 18. There is insufficient antecedent basis for this limitation in the claims.

The following art rejection is applied to applicant claims as best understood in view of the above objection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 1-6, 9-18 are rejected under 35 U.S.C. 102(e) as being unpatentable by Iwamura (US 5883621).

Regarding claim 1, Iwamura discloses an information signal transmission system (Fig. 1) comprising a first device and a second device connected in a network for providing a predetermined information signal through the first and second devices (Plurality of devices connected through IEEE- 1394 network for communicating to each other using IEEE- 1394 protocol for exchanging data); and

Recipient detecting means (Fig. 2a-b; el. 224 of DSS IRD 100) for detecting a recipient (other devices i.e. DVD 106, DVCR1 108, MD recorder 110 and DVCR2 112) of information signal (establish connectivity during bus initialization phase if the connection status of any port changes; Fig. 3) and generating identification information (Fig. 4) identifying the detected recipient (Col. 4, lines 55-Col. 5, lines 33);

Wherein the system continuously (once initialization is over, all the nodes talk to each other so to maintain connectivity) provides the information signal to the recipient (Fig. 2a-b; el. 224 of DSS IRD 100) by switching from providing the information signal to the recipient (Fig. 2a-b; el. 224 of DSS IRD 100) through the 1st device (DVD's IEEE-1394 I/O) to providing the information signal to the recipient (Fig. 2a-b; el. 224 of DSS IRD 100) through the 2nd device (DVCR1's IEEE-1394 I/O) using the identification information (Fig. 1; Col. 4, lines 40-Col. 6, lines 18), and

In switching from providing the information signal by the 1st device to providing the information signal by the 2nd device (in **1st example**, the reproducing

Art Unit: 2611

device DVD 106 playbacks the video signal and record the video signal on the DVCR1 108, the user drag/drop the DVD 106 to a 2nd DVCR2 112 connected to the network. By doing so, the Iwamura's system determines that the 1st DVCR1 does not need to receive the video signal from DVD 106 but the 2nd DVCR2 now does and notify the DSS 100 to route/switch the video playback signal from DVD 106 to the 2nd DVCR2 and DVCR1 stops recording; or in **2nd example**, the user can record DVD video signal on DVCR1 108 by drag/drop the DVD icon to DVCR1 icon. In doing so, the current video signal reproduces by DVD 106 on the TV set is routing/switching to DVCR1 108 for recording; Col. 8, lines 18-42), the information signal is provided by both the 1st and 2nd devices for a predetermined duration of time and after the predetermined duration of time has ended (i.e., in **1st example**, for synchronization purpose both DVCR1 and DVCR22 receive the same reproducing video signal for a short period of time from DVD 106; or in **2nd example** both devices DVD and DVCR1 keep connection until the process of DVD playback and DVCR1 recording is over) the information signal is provided by the 2nd device and is not provided by the 1st device (in **1st example** the received video signal from 1st DVCR1 cut off and only the 2nd DVCR2 receives the video signal for recording; in **2nd example** in turn the DVCR1 playback the recorded video from DVD and the DVD stops to play).

Regarding claim 2, it is inherent that each of the 1st and 2nd devices comprises an information signal output (video output) unit for outputting the information signal (video signal).

Regarding claim 3, wherein the 2nd device DVCR1 108 switches the operation of the information signal acquisition means based on the result detected by the recipient detecting means so that the 2nd device continuously provides the recipient with the information signal that has been provided by the 1st device (in **2nd example**, 2nd device DVCR1 108 starts to record the received video signal transmitted from 1st device DVD 106 after the drag/drop process is done; Col. 8, lines 18-42).

Regarding claim 4, wherein the 1st device switches the operation of the information signal acquisition means based on the result detected by the recipient detecting means so that the 2nd device continuously provides the recipient with the information signal that has been provided by the 1st device (in **2nd example**, the 1st device DVD 106 routes/switches the reproducing video signal to the DVCR1 108 after the drag/drop process is over so the 2nd device DVCR1 108 could record the received video signal transmitted from the 1st device DVD 106; Col. 8, lines 18-42).

Regarding claim 5, wherein the identification information is received by the recipient detecting means (Fig. 2a-b; el. 224 of DSS IRD 100) in a remote control (it is inherent in the data communication system each device is identified by its MAC address/ID so they could identify and communicate to each other over the network in using a remote control; Col. 2, lines 14-20; Col. 4, lines 33-35);

Regarding claim 6, wherein the identification information is received by the recipient detecting means (Fig. 2a-b; el. 224 of DSS IRD 100) through the operation of controls arranged in the 1st device and or the 2nd device (during initialization process, all connected devices identify themselves so the system could collect their

order of priority over the IEEE 1394 protocol so to generate a map from the topology information Col. 3, lines 20-65; Col. 5, lines 34-Col. 6, lines 5);

Regarding claim 9, it is inherent that the information signal constituted by video signal and information signal acquisition means holds a still image because during playback of a DVD program, the user could push a control pause key to freeze a video frame (still image) from the DVD program.

Regarding claim 10, further discloses wherein the information signal includes a video signal (all devices DVD, DVCR1... provides video signal over the IEEE-1394 network);

Regarding claim 11, it is inherent that a reproducing device DVD 106 reproduces a video signal recorded in a predetermined recording medium DVD disk.

Regarding claim 12, as to "wherein the RC device adds to a RC signal an Id code identifying the recipient of the information signal and the RC device transmits by a wireless transmission the RC signal" is met by Iwamura drags/drops from one device to another device, the remote control must transmits a remote control signal along with the device Ids so the system could identify the recipient device by comparing with the topology/connection map see Col. 8, lines 18-42;

Regarding claims 13-15, an information providing device/a continuous supply control method of an information providing device/a medium that stores a continuous supply control program of an information providing device for providing a predetermined information signal supplied through a network by an information reproducing device DVD 106, the information providing device comprising:

Recipient detecting means for detecting a recipient of the information signal (establish connectivity during bus initialization phase if the connection status of any port changes; Fig. 3);

Control means for reporting, after the recipient physically move (drag/drop), to the information reproducing device through the network, control information for continuously providing the recipient detected by the recipient detecting means with the information signal that has been provided to the recipient by another information providing device; wherein the recipient detecting means determines that the recipient has physically moved. (**1st example**, the reproducing device DVD 106 playbacks the video signal on the 1st DVCR1 108 for recording, the user drag/drop the DVD icon to a 2nd DVCR2 112 device connected to the network. By doing so, the system determines that the 1st DVCR1 devices 108 does not need to receive the video signal but the 2nd DVCR2 device 112 now does and notify the Iwamura's system to route/switch the video playback signal from the DVD 106 to the 2nd DVCR2 device 112 and cut off the video playback signal to the 1st DVCR1 108);

Regarding claim 16, "wherein the system switches from providing the information signal by the 1st device to providing the information signal by the second device when the recipient detecting means detects that the recipient has sent a control command to the second device using the identification information" is further met by Iwamura. In **1st example**, the reproducing device DVD 106 playbacks the video signal on the 1st DVCR1 108 for recording, the user drag/drop the DVD icon to a 2nd DVCR2 112 device connected to the network. By doing so, the system

Art Unit: 2611

determines that the 1st DVCR1 devices 108 does not need to receive the video signal but the 2nd DVCR2 device 112 now does and notify the Iwamura's system to route/switch the video playback signal from the DVD 106 to the 2nd DVCR2 device 112 and cut off the video playback signal to the 1st DVCR1 108);

Regarding claim 17, "wherein the system provides the information signal to the recipient through the 1st device in response to a 1st control command received by the 1st device, the 1st control command including the identification information; and the system switches to providing the information signal to the recipient through the second device in response to a second control command received by the second device, the second control command including the identification information" is further met by Iwamura drags/drops from one device to another device, the remote control transmits a remote control signal along with the device Ids so the system could identify the recipient device by comparing with the topology/connection map see Col. 8, lines 18-42; in doing so in **1st example**, the reproducing device DVD 106 playbacks the video signal on the 1st DVCR1 108 for recording, the user drag/drop the DVD icon to a 2nd DVCR2 112 device connected to the network. By doing so, the system determines that the 1st DVCR1 devices 108 does not need to receive the video signal but the 2nd DVCR2 device 112 now does and notify the Iwamura's system to route/switch the video playback signal from the DVD 106 to the 2nd DVCR2 device 112 and cut off the video playback signal to the 1st DVCR1 108; Regarding claim 18, "wherein the recipient is a human user" is further met by Iwamura; i.e. human interaction of Drag/drop command.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamura (US 5883621) in view of Kimura (US 5226090).

Regarding claim 7, Iwamura does not disclose wherein the recipient detecting means (Fig. 2a-b; el. 224 of DSS IRD 100) comprising speech signal acquisition means for acquiring a speech signal of the recipient of the information signal (remote control signal); and speech signal recognition means for identifying the recipient based on the speech signal, wherein the recipient of the information signal is detected based on the recognition result given by the speech signal recognition means and the identification information is based on the recognition result.

Kimura discloses a voice operated remote control to operate various AV devices by way of voice (speech) command (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Iwamura system to incorporate a voice-operated remote control, as taught by Kimura, so the system could be operated to communicate with each other devices with voice command based through sample operation of voice commands other than the operation of the keys.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or Faxed to: (703) 872-9306
for informal or Draft communications; please label "PROPOSED" or "DRAFT"

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (703) 308-7372.

Application/Control Number: 08/977,591

Page 13

Art Unit: 2611

The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

HT:ht
December 22, 2003



ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600